

ESTTA Tracking number: **ESTTA454572**

Filing date: **02/02/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054617
Party	Plaintiff Nouvelle Parfumerie Gandour
Correspondence Address	SCOTT R AUSTIN GORDON & REES LLP 200 S BISCAYNE BLVD SUITE 4300 MAIMI, FL 33131 UNITED STATES saustin@gordonrees.com, msarah@gordonrees.com, mmims@gordonrees.com
Submission	Opposition/Response to Motion
Filer's Name	Maha Sarah
Filer's e-mail	msarah@gordonrees.com
Signature	/Maha Sarah/
Date	02/02/2012
Attachments	NPG - Opposition To Motion To Dismiss.pdf (7 pages)(76364 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration)	
Registration No.: 3,504,398)	Cancellation No. 92054617
Serial No. 77/385,169)	
Filed: January 31, 2008)	
By: Y.Z.Y., Inc.)	
For the Trademark: "BIO CLAIRE")	OPPOSITION TO MOTION TO DISMISS
<hr style="border: 1px solid black;"/>		
NOUVELLE PARFUMERIE GANDOUR,)	
an Ivory Coast Corporation,)	
)	
Petitioner,)	
v.)	
)	
Y.Z.Y., Inc.,)	
a Florida Corporation,)	
)	
Respondent.)	
<hr style="border: 1px solid black;"/>		

OPPOSITION TO MOTION TO DISMISS

Petitioner Nouvelle Parfumerie Gandour ("Petitioner" or "Petitioner NPG"), respectfully submits this memorandum in opposition to the motion to dismiss for failure to state a claim under Fed.R.Civ.P. 12(b)(6) and T.B.M.P. §503 filed by Y.Z.Y., Inc. ("Registrant" or "Registrant Y.Z.Y").

I. INTRODUCTION

Registrant's motion to dismiss is neither supported by current law or by reasonable arguments for the extension or reversal of current law. Rather, it is apparent that Registrant filed the motion merely as a means to delay this proceeding.

Registrant's motion to dismiss relies on only one ground: Registrant claims Petitioner has no standing because Petitioner did not use the BIO CLAIRE Mark in the United States prior to Registrant's use of the BIO CLAIRE Mark. Based on the reasons and precedent shown in Part II below, Registrant's argument lacks credibility and is without merit. Registrant's use of the

BIO CLAIRE Mark was on behalf of the Petitioner and is attributable to the Petitioner, because Registrant was merely a conduit for Petitioner's use of its mark through sale of the Bio Claire Lightening Body Cream products in the United States.

Petitioner NPG instituted this cancellation against Registrant Y.Z.Y.'s BIO CLAIRE Mark registration (Reg. No. 3,504,398) because: (1) Petitioner is the true owner of the BIO CLAIRE Mark; (2) Registrant fraudulently obtained the BIO CLAIRE trademark registration; and (3) Registrant's use of the registered BIO CLAIRE Mark will cause confusion, mistake or deceive as to the source or origin of Registrant's goods.

As the basis for its cancellation proceeding, Petitioner alleged in paragraphs 2 and 3 that Petitioner is the creator and owner of the BIO CLAIRE Mark, having created, developed and used the mark on its cosmetic products in Ivory Coast, Africa well before selling those products using the BIO CLAIRE Mark in the United States. Registrant simply served as an importer and distributor of the product which bears the BIO CLAIRE Mark, namely "Bio Claire Lightening Body Cream".

Petitioner also alleged in paragraph 3 that Registrant began ordering Petitioner's Bio Claire Lightening Body Cream from Petitioner in 2001 and began importing and selling the product in the United States in the beginning of 2002. Further in paragraph 3, Petitioner alleged that the parties understood that the BIO CLAIRE Mark was owned by Petitioner and that Registrant's role was simply to serve as an importer and distributor of goods bearing the BIO CLAIRE Mark.

Petitioner alleged in paragraphs 4 and 8 that Registrant knew that Petitioner had prior rights in and to the BIO CLAIRE Mark as Registrant was purchasing the Bio Claire Lightening Body Cream product clearly identified with Petitioner's BIO CLAIRE Mark from Petitioner and because Petitioner's name—not Registrant's name—appeared on the product label from 2001 until at least 2011.

Petitioner alleged in paragraph 7 that Registrant was solely the distributor of Petitioner's product and Petitioner did not give Registrant consent to register the BIO CLAIRE Mark with the United States Patent and Trademark Office.

Petitioner alleged in paragraph 9 that Registrant's use of the BIO CLAIRE Mark will cause confusion, mistake or deception and has and will continue to damage Petitioner.

II. ARGUMENT

A. Standard For Deciding A Motion To Dismiss

For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the Petitioner's well-pleaded allegations must be accepted as true, and the petition for cancellation must be construed in the light most favorable to the Petitioner. *See Stanspec Co. v. American Chain & Cable Company, Inc.* 531 F.2d 563, 189 U.S.P.Q. 420 (C.C.P.A.) 1976). In order to withstand such a motion, Petitioner's pleading need only allege such facts as would, if proved, establish that the Petitioner is entitled to the relief sought, that is, that (1) the Petitioner has standing to maintain the proceeding, and (2) a valid ground exists for canceling the subject registration. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 6670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres*, 56 U.S.P.Q.2d 1538 (T.T.A.B. 2000); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 U.S.P.Q.2d 1460 (T.T.A.B. 1992); *Hartwell Co. v. Shane*, 17 U.S.P.Q.2d 1569 (T.T.A.B. 1990). Dismissal for insufficiency is appropriate only if it appears certain that the Petitioner is entitled to no relief under any set of facts that could be proved in support of its claim. *See Kelly Services Inc.*, 25 U.S.P.Q.2d at 1462.

B. Petitioner Sufficiently Alleged Standing

There can be no doubt that Petitioner has standing and that Petitioner sufficiently pleaded standing in its Petition. As alleged in the Petition:

- Petitioner NPG is the creator of the mark and coined the term "BIO CLAIRE." Petitioner created the BIO CLAIRE Mark and brand on or around February 2001 in the Ivory Coast

and Cameroon. The BIO CLAIRE Mark was registered in Cameroon through the African Intellectual Property Organization, effective August 30, 2002, claiming a first use in 2001. (Petition, par. 2.)

- Registrant Y.Z.Y. is a distributor of Petitioner NPG. Registrant began ordering Petitioner's Bio Claire Lightening Body Cream product from Petitioner in or about October 2001, and began selling this product in the United States in the beginning of 2002. The parties understood that the BIO CLAIRE Mark was owned by Petitioner and that Registrant's role was simply to serve as an importer and distributor of these goods, not the source of these goods or the owner of the BIO CLAIRE Mark. (Petition, par. 3, emphasis added.)
- Although Registrant Y.Z.Y. has attempted sell Petitioner's product in the United States as its own, Petitioner's name, along with Petitioner's Mark appeared on the product's label from 2001 until at least 2011. Registrant's name did not appear on the product label in any manner during that time period. (Petition, par. 4, emphasis added.)
- In 2011, Registrant began offering for sale and selling counterfeits of Petitioner's products using the BIO CLAIRE Mark. It was not until Registrant began offering and selling the counterfeits, that Registrant's name appeared on the counterfeit labels. (Petition, par. 5.)
- Petitioner did not give Registrant permission to use the BIO CLAIRE Mark in any manner—Registrant was solely the distributor of Petitioner's product. Nor did Petitioner give Registrant its consent to register the BIO CLAIRE Mark with the United States Patent and Trademark Office. (Petition, par. 6, emphasis added.)

Thus, Petitioner's use of its BIO CLAIRE Mark in the U.S. through Registrant as the distributor, precedes any independent use of the BIO CLAIRE Mark by Registrant. Indeed, Registrant's only "independent" use of the BIO CLAIRE Mark is in 2011, when Registrant began offering for sale and selling counterfeits of Petitioner's products using the BIO CLAIRE Mark. (Petition, par. 5.) It was not until Registrant began offering and selling these counterfeits, that Registrant's name appeared on the counterfeit labels. (*Id.*)

Furthermore, as alleged in the Petition, Registrant will enjoy unlawful gain and advantage to which it is not entitled because Petitioner fraudulently obtained the BIO CLAIRE registration in violation of 15 U.S.C. § 1064(3). (Petition, par. 8.) Petitioner's use of the BIO CLAIRE Mark will also cause confusion, mistake or deceive as to the source or origin of Registrant's

goods by creating the erroneous impression that Registrant's goods originate with, are sponsored, approved, endorsed, licensed by, affiliated, or associated with, or in some other way legitimately connected to Petitioner, the Petitioner's Mark or its goods. (Petition, par. 9.) Such confusion, mistake or deception by Registrant's use of the BIO CLAIRE Mark has and will continue to damage Petitioner. (Petition, par. 9.) As a result, Petitioner has a real interest in this proceeding and reasonable basis for its belief of damage. *See Kelly Services Inc.*, 25 U.S.P.Q.2d at 1462; *Lipton Industries, Inc.*, 213 U.S.P.Q. at 189.

C. A Foreign Manufacturer And Owner Of A Mark Will Be Deemed To Have Established Trademark Rights, Use and Priority In Its Mark Through Sales To A U.S. Distributor In The U.S.

A manufacturer's "sale and shipment of products bearing a trademark to [a] distributors is sufficient to establish trademark rights". *Raintree Publishers, Inc. v. Brewer*, 218 USPQ 272 (TTAB 1983). This rule equally applies to foreign manufacturers. *See Jean D'Albret v. Henkel-Khasana GmbH*, 185 USPQ 317, 320 (TTAP 1975) ("It is clear from the record that petitioner herein has been engaged in commerce which may lawfully be regulated by Congress, namely, commerce between France and the United States, through shipments and sales of 'CRÈME B-21' product to its importer..."). As previously discussed, "the importer of goods bearing the mark of a foreign manufacturer does not acquire any rights in the trademark merely by importing the goods and selling them in the United States." *Bakker v. Steel Nurse of America, Inc.*, 176 USPQ 447 (TTAB 1972). Therefore, the foreign manufacturer may establish priority based on its first sale and shipment of its goods bearing the mark to the US distributor.

Based on the foregoing, Petitioner, a foreign manufacturer, has established U.S. trademark rights, in its BIO CLAIRE Mark, namely use in commerce and priority through the first sale and shipment of its BIO CLAIRE Lightening Body Cream products to Registrant as its

U.S. distributor. By merely importing and selling goods bearing Petitioner's BIO CLAIRE Mark in the U.S., Registrant acquired no rights in Petitioner's BIO CLAIRE Mark.

III. CONCLUSION

Wherefore, based on the foregoing, Petitioner respectfully requests that Respondent's motion to dismiss be denied. In the alternative, Petitioner requests that it be permitted to amend its Petition if the Board notes any deficiencies.

Date: February 2, 2012

Respectfully submitted,

GORDON & REES LLP

/s/ Scott R. Austin

Scott R. Austin

Florida State Bar No. 434140

saustin@gordonrees.com

200 S. Biscayne Blvd, Suite 4300

Miami, FL 33131

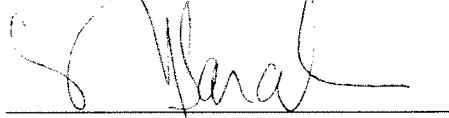
Phone: (305) 668-4433

Fax: (877) 634-7245

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above document was filed electronically with the Trademark Trial and Appeal Board on this 2nd day of February 2012.

GORDON & REES LLP



Maha Sarah

Certificate of Mailing by Federal Express

I hereby certify that a copy of this OPPOSITION TO MOTION TO DISMISS is being served by **Federal Express Overnight Courier** to the below addressee on February 2nd, 2012, as follows:

Fed Ex 798018755760

RICHARD S. ROSS, ESQ.
4801 S. UNIVERSITY DR. STE. 237
FT. LAUDERDALE, FL 33328-3836

Fed Ex 793188302487

Y.Z.Y., INC.
6300 N.W. 72ND AVENUE
MIAMI, FL 33166

Date of Mailing: February 2, 2012

Printed Name: Monica Mims

Signature:

